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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,788	06/06/2000	Heng-Ming Hsu	67,200-262	9280

7590 06/09/2006  
Tung & Associates  
838 W. Long Lake Road  
Suite 120  
Bloomfield Hills, MI 48302

EXAMINER
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TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
3729	

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/588,788	<b>Applicant(s)</b> HSU ET AL.	
	<b>Examiner</b> A. Dexter Tugbang	<b>Art Unit</b> 3729	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attachment. (See 37 CFR 1.116 and 41.33(a)).

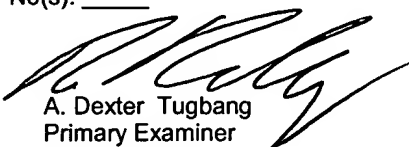
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,4-8,16.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
A. Dexter Tugbang  
Primary Examiner  
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Attachment to Advisory Action

I. Finality of Office Action

The applicant(s) urge that the finality of the last Office Action (dated March 2, 2006) was premature and improper.

The examiner most respectfully disagrees that the finality of the last Office Action was premature and relies upon the following sections of the MPEP to support the examiner's position that the finality of the last Office Action was not premature and was proper.

In the BPAI decision (dated September 13, 2005), the claim language was considered to be indefinite. So much so, that the Board could not even decide on the merits of the prior art as applied in the Final Rejection (dated March 2, 2006). The Board relied upon the following section in making a new grounds of rejection under 112, 2<sup>nd</sup> paragraph.

**2173.06 Prior Art Rejection of Claim Rejected as Indefinite**

Second, where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), **a rejection under 35 U.S.C. 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.**

(Also noted on page 4 of the BPAI Decision filed on September 13, 2005).

This new grounds of rejection by the BPAI was considered to be a Non-Final rejection pursuant to 37 CFR § 41.50(b), which in effect reopened prosecution.

As a result of the Non-Final rejection by the BPAI, the applicant(s) filed on amendment (on November 11, 2005) to clarify the claim language and overcome the 112, 2<sup>nd</sup> paragraph rejection by the BPAI.

At this point, the examiner noted that the 112, 2<sup>nd</sup> paragraph rejection was overcome by the amendment, but that the claims did not overcome the prior art, particularly with respect to Romankiw et al. **The rejection of Romankiw is merely the same rejection that was presented in the Final Rejection (dated October 31, 2003).** Thus, the rejection is not a new rejection to the extent that Romankiw is still being applied as the primary reference. While the reference to Church et al is a newly cited reference, Church was cited as extrinsic evidence to further show that Romankiw inherently teaches that the spiral conductive layer is formed with a progressive and discontinuous variation of a series of linewidths in a successive series of loops (*as amended* on November 11, 2005). The examiner is certainly entitled to cite a new reference to show that a certain characteristic is inherent in the primary reference pursuant to:

#### **2131.01 Multiple Reference 35 U.S.C. 102 Rejections**

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an “enabled disclosure; ”
  - (B) Explain the meaning of a term used in the primary reference; or
  - (C) **Show that a characteristic not disclosed in the reference is inherent.**
- See paragraphs I-III below for more explanation of each circumstance.

#### **...III. TO SHOW THAT A CHARACTERISTIC NOT DISCLOSED IN THE REFERENCE IS INHERENT**

Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the Thing Taught by the Primary Reference.

However, even if the applicant(s) continue to believe that the rejection in the last Office Action was a new grounds of rejection, based on the newly cited reference to Church et al, that this rejection was still considered to be properly made **final that was necessitated by amendment** (filed on November 11, 2005) pursuant to:

#### **1214.01 [R-3] Procedure Following New Ground of Rejection by Board**

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If the examiner does not consider that the *amendment* and/or **\*\*>new evidence<** overcomes the rejection, he or she will again reject the claims. **If appropriate, the rejection will be made final.**

and

#### **706.07(a) [R-3] Final Rejection, When Proper on Second Action**

Under present practice, **second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims** nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

To say that the amendment to the claims would have been reasonably expected by the examiner goes way beyond a stretch of the examiner's imagination because the examiner could not have possibly read the applicant(s) mind as to how the claims would have, or could have, been amended and the examiner had no way of making any reasonable determination as to what precise claim language would be used to overcome the decision by the BPAI.

Accordingly, the procedure and finality of the last Office Action is considered to be proper.

## **II. Amendment to the Claims After Final**

In the proposed After Final amendment filed on May 24, 2006, the amendment will not be entered for the following reasons.

The changes to the claims, particularly the new limitations added to Claim 1 (at line 2, lines 8-9, lines 11-12 and at line 14) and to Claim 4 (at line 2, lines 7-11 and at line 13), narrow the scope of the claims significantly to the extent that new issues would be raised that would require further consideration and/or search by the examiner.

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Moreover, new Claims 17 and 18 have been proposed to be added without canceling a corresponding number of previously rejected claims, as these new claims would additionally raise new issues requiring further consideration and search by the examiner.